

REMARKS

This responds to the Office Action dated May 14, 2009.

Claims 1, 6-10, and 14-15 are amended; no claims are canceled or added; as a result, claims 1-16 stand pending in this application. The amendments are fully supported by the current application as shown in the following table and do not add new matter.

Claim limitation:	Support in the original specification:
“receiving from at least one subscriber a selection of a first priority level associated with the first advertisement, and a second priority level associated with the second advertisement,”	<p>P. 3, line 30 thru p. 4, line 6: “[A] viewer can <u>select</u> the type and/or <u>level</u> of advertising the viewer wishes to view, rather than being faced with advertisements for which the viewer has no interest. The viewer can use any one or combination of selection choices including, without limitation, remote control selection at any time during viewing session or at beginning of viewing session, manual selection switches associated with a set top box, selection based on programming in a remote control device, selection based on who is using the remote control, pre-programmed set top box, etc.”</p> <p>P. 25, lines 13-15 “Further, a viewer may <u>select</u> multiple categories of upgraded advertisements and may specify a ranking or <u>priority</u> of categories in the event that two categories are available at one time.”</p> <p>P. 3, lines 19-26 “first computer program code operating on the processor that detects the first advertisement indicator and the second advertisement indicator and compares the category of the first advertisement and the category of the second advertisement to a stored category value and that compares <u>the priority level of the first advertisement</u> with <u>the priority level of the second advertisement</u> and that selects the first advertisement</p>

	unless the category of the second advertisement is in agreement with the stored category value and the priority level of the second advertisement is greater than or equal to the priority level of the first advertisement;"
"and storing the selection in a set top box of the at least one subscriber;"	<p>Original claim 9: "The set top box of claim 8 further comprising computer program code that processes <u>a user input</u> and <u>stores said stored category value in said set top box</u>."</p> <p>FIG. 8: "Selection Control Information" 810 is part of Set Top Box 818.</p> <p>P. 18, lines 6-7: "[A]dvertising information may comprise selected <u>categories</u>, tables, executable code or <u>other information</u> that may be stored in selection control information 810 . . ."</p> <p>Applicants assert that support is shown above for the subscriber's selecting the category or type of advertising and/or priority level of advertising. Storing the "categories" in the Selection Control Information 810 of Set Top Box 818 is explicitly stated above, and by implication the priority level must be part of the "other information" that may also be stored there.</p>

Examiner Interview Summary

Applicants would like to thank Examiner Jason Thomas and Supervising Examiner Andrew Koenig for the courtesy of a phone interview on July 20, 2009 between the Examiners and Applicants' representatives Walter Nielsen and Ali Mireshghi. During the interview, claim 1 and several of the applied references were discussed, but no agreement was reached other than that Applicants would amend the independent claims of the application to try to place them in condition for allowance.

§ 103 Rejection of the Claims

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Matz (U.S. Patent Application Publication No. 2004/0261096) in view of Allen (U.S. Patent Application Publication No. 2004/0078814), Miller (U.S. Patent No. 7,266,832), Hord (U.S. Patent Application Publication No. 2004/0034874), and Pudar (U.S. Patent Application Publication No. 2002/0184091). Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

“A rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known in the prior art* and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.”¹ (Emphasis added.)

Applicants will show that the applied references, singly or in combination, neither teach nor suggest all limitations of Applicants' claims.

For at least the reasons set forth below, Applicants respectfully submit that the identified claims are non-obvious over the combination of Matz, Allen, Miller, Hord, and Pudar, and are therefore in condition for allowance.

Independent claim 1, as amended now reads, in pertinent part, as follows:

“receiving from at least one subscriber a selection of a first priority level associated with the first advertisement, and a second priority level associated with the second advertisement, and storing the selection in a set top box of the at least one subscriber”

Applicants respectfully submit that the cited references, individually or as part of any combination, do not teach or suggest the above-quoted limitation. Matz is directed to “a method for monitoring termination of blocked contents.”² Specifically, Matz states as follows:

¹ *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007)

² Matz, Abstract

“... the preference data storage 405 stores data related to a user's viewing history. The preference data 405 may include data such as, but not limited to, preferred tags, time duration of viewing categories/subcategories of content, and user input, such as mouse clicks or remote control data entries.”³

As evident from the above-quoted passage, in Matz preference data is related to a user's viewing history and includes preferred tags, time duration of viewing categories/subcategories of content, etc. However, Matz does not describe the limitation of “*receiving from at least one subscriber a selection of a first priority level associated with the first advertisement, and a second priority level associated with the second advertisement, and storing the selection in a set top box of the at least one subscriber,*” as recited in amended independent claim 1.

Allen provides a “module-based ticker for an interactive television system [that] comprises one or more modules of content that the user can select for presentation.”⁴ Allen, in particular, states “[s]ervers 114 may provide advertisements for insertion into multimedia content delivered by the content source 104.”⁵ Nonetheless, Allen is totally silent with respect to the above-discussed claim limitation.

Miller is directed to a “system and method to use an aggregator in an interactive television system in connection with advertisement swapping.”⁶ Miller further specifies “subscribers can be opted-in for the advertisement substitution service, such that only opted-in subscribers receive substitute advertisements.”⁷ Nevertheless, Miller fails to describe the above-discussed limitation of amended independent claim 1.

Hord is directed to a “system for presenting advertisements to a user during video presentations . . . to detect a trick mode activation . . . then present an advertisement during a trick mode display of the media content instance presentation.”⁸ However, the Hord reference is totally silent about the above-discussed limitation.

Pudar provides a “radio broadcast system [including] a vehicle-based radio system that receives radio broadcasts via digital satellite transmission from a transmitting facility and

³ Id., paragraph 0083

⁴ Allen, Abstract

⁵ Id., paragraph 0031

⁶ Miller, Abstract

⁷ Id., col. 10, lines 11-13

⁸ Hord, Abstract

provides two-way communication with a vehicle communications central facility.”⁹ Pudar specifically states, “Priority data can be used to determine which of a number of suitable, stored advertisements should be played.”¹⁰ Pudar further states, “the Priority field could be used so that a default advertisement having a relatively high priority would not be replaced with a stored advertisement having lower priority.”¹¹ Nevertheless, Pudar does not describe the above-discussed limitation of amended independent claim 1.

Accordingly, at least for the reasons set forth above, Matz, Miller, Allen, Hord, and Pudar, separately or as part of any combination, fail to teach or suggest each and every limitation of amended independent claim 1. Therefore, Applicants respectfully submit that there are substantial differences between what is claimed and what is shown in Matz, Miller, Allen, Hord, and Pudar, whether they are considered separately or as part of any combination. Furthermore, nothing in the disclosures of Matz, Miller, Allen, Hord, and Pudar provides a reason for a person of ordinary skill in the art to seek to combine Matz, Miller, Allen, Hord, and Pudar in the manner suggested by the Examiner. Accordingly, amended independent claim 1 and its dependent claims 2-5 are not rendered obvious by the proposed combination in the Office Action, and thus they are asserted to be in condition for allowance. Further, dependent claims may also be patentable for their own limitations.

Independent claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Matz in view of Miller and Pudar.

Amended independent claim 6 recites a substantially analogous limitation as discussed above with respect to amended independent claim 1. Thus, at least for the reasons articulated above, amended independent claim 6 is non-obvious over the combination of Matz, Miller, and Pudar and is therefore in condition for allowance.

Independent claims 7 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Pudar and Dudkiewicz (U.S. Patent No. 6,973,665).

⁹ Pudar, Abstract

¹⁰ Id., paragraph 0035

¹¹ Id., paragraph 0029

Amended independent claims 7 and 14 recite substantially analogous limitations as discussed above with respect to amended independent claim 1. Dudkiewicz fails to cure the defect in the combination of Miller and Pudar. Thus, at least for the reasons asserted above, amended independent claims 7 and 14 are non-obvious over the combination of Miller, Pudar, and Dudkiewicz, and they are thus in condition for allowance.

Claims 8, 11-13 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Pudar.

Amended independent claims 8 and 15 recite substantially analogous limitations as discussed above with respect to amended independent claim 1. Thus, at least for the reasons articulated above, amended independent claims 8 and 15 and dependent claims 11-13 are not rendered obvious by the combination of Miller and Pudar, and they are thus in condition for allowance.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Pudar and Matz.

Claim 9 is dependent on claim 8 and is deemed to include all limitations of independent claim 8. Thus, at least for the reasons articulated above, dependent claim 9 is also in condition for allowance.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Pudar and Wachob (U.S. Patent No. 5,155,591).

Claim 10 is dependent on claim 8 and is deemed to include all limitations of independent claim 8. Thus, at least for the reasons articulated above, dependent claim 10 is not rendered obvious by the combination of Miller and Pudar. Wachob fails to cure the defect in the combination of Miller and Pudar. Therefore, claim 10 is non-obvious over the combination of Miller, Pudar, and Wachob, and it is also in condition for allowance.

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Pudar and Matz.

Claim 16 is dependent on claim 1 and is deemed to include all limitations of independent claim 1. Thus, at least for the reasons articulated above, dependent claim 16 is also in condition for allowance.

Therefore, Applicants respectfully request that the claim rejections under 35 U.S.C. §103(a) be reconsidered, in light of the amendments to the independent claims, and withdrawn.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4053 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14 day of August, 2009.

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